

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	David M. Pepper et al.	)	Examiner:	Brandi N. Thomas
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Serial No.:	10/661,028	)	Art Unit:	2873
		)		
Filed:	09/11/2003	)	Our Ref:	B-4077 618504-4
		)		
For:	“Optical Retro-Reflective Apparatus with Modulation Capability ”	)	Date:	October 2, 2009
		)	Re:	<i>Proposed Agenda</i>

**Proposed Agenda**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

SPE Ricky Mack has tentatively set a telephonic interview to occur at 1:30 PM on Monday, October 5, 2009. Examiner Mack requested that the applicant submit an agenda and that is done with this paper. The proposed agenda begins on page 2 of this paper.

## Proposed agenda

I. The recent Official Action is the seventh non-final official action to issue. No amendments have been made to the original independent claims in response to any of the six prior official actions. This is clearly a case of piecemeal prosecution. A first Office Action on the merits should ordinarily identify every issue that stands between the applicant and allowance of the application. See MPEP §707.07(g)). And, the Office Action should do so by presenting the best case against patentability in that initial Official Action. See, for example, MPEP §§2164.04 and 2106II. Why has this application been subjected to so much needless prosecution? The cost of prosecuting a patent application is high and it is unfair to the assignee of this application to engage in continuing rounds of prosecution which seemingly go nowhere.

II. The Examiner rejects Claims 6, 7, 9-10 and 33-40 under 35 U.S.C. §102 as allegedly being fully anticipated by Applicant's Admitted Prior Art (AAPA). With respect to claim 6, the Examiner asserts on page 2 of the most recent Official Action that figures 4a and 4b of the present application show an optical retro-reflective apparatus for modulating an optical beam. The Examiner's assertion is, with all due respect, not correct. Figures 4a and 4b show a switchable grating element. A switchable grating element is known *per se* in the prior art. However, the switchable grating element of figures 4a and 4b is not a retro-reflecting device! What is especially confusing is that the Examiner asserts on page 9 (see lines 10-12 ) of the Official Action that Figures 4a and 4b do not depict a retro-reflective device. That assertion, which is correct, is the direct opposite of what the Examiner says in the opening lines of the rejection on page 2 of the Official Action. So why are claims 6, 7, 9-10 and 33-40 rejected under 35 U.S.C. §102 as allegedly being fully anticipated by Applicant's Admitted Prior Art (AAPA)?

On the other hand, Figure 4 of the present application does show a retro-reflecting device. which can make use of the prior art switchable grading device of Figures 4a and 4b. The retro-reflecting modulator of Figure 4 is not admitted prior art. But the Examiner appears to be citing

applicant's invention of Fig. 4 against the claims in this application. Why? What is the basis for doing that? Since Figures 4a and 4b do not anticipate the claims, this rejection is improper. Moreover it is improper for the Examiner to refer to applicant's detailed description of his own invention as a rationale for rejecting the claims. Note the Examiner's reference to page 10 of the application as filed in the rationale for rejecting claim 6 on page 2 of the recent Official Action. That is part of the detailed description of the invention. It is not part of the prior art!

III. When citing prior art, be it AAPA or otherwise, why does the Examiner fail to identify which portions she relies upon in the manner required by 37 CFR 1.104? Note, for example, the rejections of claims 33 and 35, wherein the examiner cites Figures 1, 2a and 2b of the AAPA. Those figures shown multiple reflective surfaces. Which ones is she referring to in the rejection? In any event, no matter which reflective surfaces the examiner considers, Figures 1, 2a and 2b fail to teach "were in the first reflective surface and the second reflective surface are parallel to each other in the first position and the second positive" as claimed. So why are these claims rejected?

IV. Turning to the rejection of claim 35, the examiner also rejects that claim based upon Figures 1, 2a and 2b of AAPA. The examiner's rationale for rejecting claim 35 is improper in that the examiner uses the language of claim 33 to reject claim 35. That is highly improper. Claim 35 recites, inter-alia, "a retro-reflecting structure including a substrate and a moveable grading structure". No such apparatus can be found in Figures 1, 2a and 2b of AAPA. Can the Examiner point to such structure in those figures? The rejection of claim 35 and its dependent claims 39 and 40 is improper.

V. Turning to the rejection of claims 1, 2, 5, 22-26 and 41 under 35 U.S.C. §103 based upon AAPA in view of Browning, the Examiner still has not provided the Applicant with a reasonable explanation of just how the technology represented by Figures 1, 2a and 2b of the AAPA would be modified based upon the teachings of Browning.

Yes, the Examiner can find the mere words of applicant's claims in the prior art. The words are old. The Examiner might as well be citing a dictionary. It is the context of the words which is important and so far the rejection seems to be little more than pointing to similar words and an opinion that the claimed invention must be obvious. But it is the context of the words which is important and it is the context of the invention as claimed which is not being addressed.

Browning teaches a Fabry-Perot structure. Of course, Figure 1 of applicant's AAPA shows a laser 10 which those skilled in the art would realize would likely include a Fabry-Perot structure (see <http://www.photonics.com/Directory/Dictionary/Definition.aspx?type=2&DictionaryID=3961>). So let us assume for the moment that Browning's Fabry-Perot structure is to be used in place of laser 10 shown in the Figure 1 of the AAPA. The laser 10 would then have the two mirrors which the Examiner refers to in Browning. Of course, those skilled in the art know fully well that lasers tend to have two mirrors which retro-reflect within a Fabry-Perot cavity within the laser, just as Browning does. And one of those mirrors is partially reflective and partially transmissive so that a laser beam 12 emerges from the device. This is all very well known in the art.

But if you compare this with claim 1, claim 1 recites a retro-reflecting Fabry-Perot structure which includes a pair of moveable surfaces. Importantly, claim 1 also recites "a micromechanical device for moving at least one of the reflective surfaces of said pair of reflective surfaces relative to one another a distance which causes the pair of reflective surfaces to switch between a reflective mode of operation and a transmissive mode of operation".

Well, if Browning's Fabry-Perot structure some how intended to modify the Fabry-Perot structure that typically incurs within laser 10 of Figure 1, that limitation is not met. The Examiner points to the electromechanical device 26 shown in Figure 2a, but that device is not used to move two mirrors which form a Fabry-Perot structure. The Fabry-Perot structure is in laser 10, not in item 20 shown in Figures 1, 2a and 2b. And if item 20 is to somehow morph into a Fabry-Perot structure with moveable mirrors, the Examiner has not provided the reasoned analysis envisioned by KSR as to who any why that might be obvious in view of the prior art.

The Examiner states that the test is "what the combined teaching's of those references would have suggested those of ordinary skill in the art." That is exactly what the Applicant wants to know. If it is anything other than putting a Fabry-Perot structure into element 10 (which lasers normally have anyway), exactly what is the asserted combined teachings of the AAPA and Browning that the Examiner believes would have suggested some other structure to those of ordinary skill in the art? And exactly what does that structure look like and how it is derived from the prior art?

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(Date of Transmission)

Christina Cigliano  
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